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OFFICE OF PETITIONS

In re Application of
T. William Hutchens et al.
Application No. 10/728,442
Filed: December 5, 2003
Attorney Docket No. 016866-001507
Title: METHOD AND APPARATUS FOR
DESORPTION AND IONIZATION OF
ANALYTES

DECISION ON PETITION

This is a decision on the "Response to Notice to File Corrected Application Papers," filed March 3, 2004, which is properly treated as a petition under 37 C.F.R. 1.53, requesting that the above-identified application be accorded a filing date of December 5, 2003, with the abstract submitted with the instant petition considered as part of the original disclosure of the application. Petitioner has also submitted replacement drawings.

The application was deposited December 5, 2003. However, on January 23, 2004, the Office of Initial Patent Examination (OIPE) mailed a "Notice to File Corrected Application Papers (notice)," stating that the application had been accorded a filing date, and advising applicants that the application appeared to have been deposited without an abstract and Figures 7A-7D, 12A, 12B, 14A, and 14B. With the instant petition, Petitioner has submitted 21 sheets of "replacement drawings," an abstract, and a statement of facts.

Regarding the drawings, Petitioner does not assert that the above-mentioned Figures were included on filing, which suggests that they were in fact omitted on filing. As such, the drawings submitted with the instant petition, will not be entered. If petitioner desires for the examiner to consider the missing figures which were not submitted as part of the original disclosure, then petitioner may submit those pages as an amendment. Any such amendment will, of course, be

reviewed by the examiner for new matter¹. The amendment is not new matter if the substance was a part of the disclosure of the prior application.

Regarding the abstract, Petitioner states that the abstract was constructively included on filing, through incorporation by reference. The Office allows an applicant to rely upon an incorporation by reference of a parent application when a portion of the child application has been inadvertently omitted. It is noted that the application transmittal letter identifies this application as a continuation of prior application 09/809,657, and specifically incorporated by reference the disclosure of the prior application. Section 201.06(c) of the MPEP sets forth, in part:

an applicant may incorporate by reference the prior application by including, in the continuation or divisional application-as-filed, a statement that such specifically enumerated prior application or applications are "hereby incorporated herein by reference." The statement may appear in the specification or in the application transmittal letter. The incorporation by reference statement can only be relied upon to permit the entering of a portion of the prior application into the continuation or divisional application when the portion of the prior application has been inadvertently omitted from the submitted application papers in the continuation or divisional application. The inclusion of this incorporation by reference of the prior application(s) will permit an applicant to amend the continuation or divisional application to include any subject matter in such prior application(s), without the need for a petition provided the continuation or divisional application is entitled to a filing date notwithstanding the incorporation by reference.

(Emphasis added).

If petitioner desires for the examiner to consider the missing abstract which was not submitted as part of the original disclosure, then petitioner may submit that page via an amendment. Again, any such amendment will, of course, be reviewed by the examiner for new matter². The amendment is not new matter if the substance was a part of the disclosure of the prior application.

For these reasons, the petition under 37 CFR 1.53(b) is dismissed.

Neither the drawings nor the abstract submitted with the instant petition, will be entered. Should petitioner wish for these pages to be entered, an amendment must be filed. The original application papers will include only those application papers present on the date of deposit. The petition fee of \$130.00 will not be refunded, as this petition was not necessitated by any error on the part of the Office.

The Application is being returned to the Office of Initial Patent Examination for further processing with a filing date of December 5, 2003, using only the application papers filed on that date.

Telephone inquiries specific to this matter should be directed to the undersigned at (703) 305-0011.



Paul Shanoski
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United States Patent and Trademark Office

¹ See MPEP 608.02(h) and 608.04.

² Id.